



18 FEB 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. Box 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

23372  
TAYLOR, RUSSELL & RUSSELL, P.C.  
4807 Spicewood Springs Road  
Building Two, Suite 250  
Austin, TX 78759

In re Application of  
HENDERSON, Timothy David Robert  
U.S. Application No.: 10/708,471  
Filing Date: 05 March 2004  
Attorney Docket No.: 800769  
For: RESILIENT ELASTOMERIC  
STRUCTURE

**DECISION ON  
RENEWED PETITION  
TO CONVERT**

This decision is in response to applicant's "Request for Reconsideration on Petition to Convert" filed via facsimile on 05 November 2004.

**BACKGROUND**

On 05 March 2004, applicant filed the above-captioned application using the Electronic Filing System (EFS). Applicant intended that the above-captioned application be processed as a national stage filing under 35 U.S.C. 371. However, the application was processed as a filing under 35 U.S.C. 111(a) because a filing under 35 U.S.C. 371 is not allowed using the EFS.

On 09 June 2004, applicant filed a petition to convert the above-captioned application to a national stage of PCT/GB02/04050.

On 14 September 2004, a decision dismissing applicant's petition to convert was mailed. Applicant failed to show a loss of any patent rights required for a grantable petition to convert.

On 05 November 2004, applicant filed the instant request for reconsideration of the decision on the petition to convert which was accompanied by, *inter alia*, a copy of an EFS Continuity screen and a copy of the filing receipt for the above-captioned application.

**DISCUSSION**

The decision mailed 14 September 2004 noted that the above-captioned application was properly processed pursuant to 35 U.S.C. 111(a) as use of the EFS is not allowed for filing a national stage application. Accordingly, applicant's request to convert the above-identified application to a national stage filing under 35 U.S.C. 371

was dismissed because applicant had not made a showing that a loss of patent rights would occur if the above-captioned application is a filing under 35 U.S.C. § 111(a).

In the request for reconsideration, applicant argues:

(1) The continuity data screen shown for an EFS application in Exhibit A would allow a national stage application to be filed electronically;

(2) Petitioner contacted the USPTO Electronic Business Center who confirmed that a national stage application filed in the EFS would be processed as a national stage application;

(3) The EFS Frequently Asked Questions cited in the prior decision was not apparent to the petitioner at the time of filing and even if it was, the confirmation of the ability to file electronically, the action taken by petitioner would have been the same;

(4) A loss of patent rights would occur because the petitioner has not received the benefit of claiming the priority date to the parent foreign application.

These claims will be addressed in turn:

### **Continuity Data Screen**

Petitioner claims that the continuity data screen allows a national stage application to be filed electronically. However, that is not the case. The continuity data screen on an EFS application allows an applicant to file a continuation, divisional, or continuation in part application of a PCT application only. See MPEP § 1895.

The filing of a national stage application using the EFS is not possible.

### **Purported Telephone Call to Electronic Business Center**

The petitioner also claims that in a “telephone call to the USPTO Electronic Business Center” it resulted in a confirmation that “a PCT National Stage application filed electronically in the EFS would be received and treated as a Pct National Stage application under 35 U.S.C. ¶ 371.”

A check with the USPTO Electronic Business Center Help Center did not result in confirmation of applicant’s claim as the representative reiterated that filing of a national stage application using the EFS is not possible.

Regardless, in accordance with 37 CFR 1.2, “[a]ll business with the Patent and Trademark Office should be transacted in writing.” Further, “[t]he action of the Patent

and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt." Therefore, any telephone discussion between applicant and an unnamed member of the Electronic Business Center of the USPTO will not be considered in this decision. See also *Farnum v. Manbeck, Jr.*, 21 USPQ.2d 1691 (D.D.C. 1991) (holding that applicant's arguments asserting oral misrepresentations by USPTO personnel or irrelevant in light of 37 CFR 1.2.).

### **Information on FAQ Not Apparent**

The petitioner also argues that the "EFS Frequently Asked Questions cited in the Decision on Petition to Convert was not apparent to the petitioner at the time of filing on March 5, 2004."

This argument is dismissed as each practitioner registered with the Office is responsible for maintaining familiarity with Office practice. Moreover, the link to the FAQ's is clearly listed on the EFS webpage. The petitioner should have checked this before filing the above-captioned application.

### **Loss of Patent Rights**

In the request for reconsideration, applicant's claim a loss of patent rights and contend:

Petitioner has not received the benefit of claiming priority date to the patent priority application number 0121655.5 filed in the United Kingdom on September 7, 2001, and the subsequently filed PCT application. . . . Without a claim of continuation to the intervening PCT application, the time period between the filing of the parent application in the United Kingdom and the child application in the United States is greater than 12 months, which would result in a loss of patent rights in the United States.

Applicant's petition to convert would be granted if no other remedy is available. However, another remedy is available.

Applicant may claim priority to the aforementioned British patent pursuant to 35 U.S.C. 119. Applicant is also entitled to claim the benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application PCT/GB02/04050 for the common subject matter, since this application and the international application designating the United States were copending on 05 March 2004. A petition under 37 CFR 1.78 and an appropriate petition fee would be required.

Since another remedy is available, no loss of patent rights would occur.

**DECISION**

For the reasons discussed above, applicant's renewed petition to convert is **DISMISSED** without prejudice.

Any renewed petition to convert must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to Technology Center 3700 for further processing under 35 U.S.C. 111(a).

  
James Thomson  
Attorney Advisor  
PCT Legal Office

Tel.: (571) 272-3302